



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,656	06/29/2001	Alan C. Berkema	10016784-1	9732

7590 07/14/2005

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

POLTORAK, PIOTR

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/897,656	BERKEMA ET AL.
	Examiner Peter Poltorak	Art Unit 2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 April 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 4,5,9-12,15,18-22,32-34 and 37-39 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 4-5, 9-12, 15, 18-22, 32-34 and 37-39 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____.



DETAILED ACTION

1. The Amendment, and remarks therein, received on 4/14/2005 have been entered and carefully considered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Response to Amendment

3. The following applicant's arguments have been carefully considered but they were not found persuasive.
4. As per claim 5 applicant argues that *Larsson* does not describe a wireless device sending reference to a printer, the reference including information allowing the print device to supply the reference to a print service to cause the print service to retrieve the print content.
5. This argument has been carefully considered by was not found persuasive. The examiner points to *Larson*, who teaches a wireless device (a cellular telephone) supplying a document address to a print device communication device (300b), which is a part of a printer (380, Fig. 1). The document address and the printer specification is transmitted to the information service provider (pg. 13, lines 34-35). The information service provider (200) is a server for serving the documents and provides access to documents or other browsable information (pg. 13 lines 11-15), and a print service device (200) implemented in the information service provider and handling the request of a document to be printed (pg. 13 lines 15-22). Afterwards the retrieved document is sent back to the target printer (pg. 17 lines 27-31).

6. Furthermore, applicant argues that *Larsson's* teaching is not consistent with applicant's invention because unlike in *Larsson's* teaching applicant's invention permits the print by reference operation to address a print service and content that are in different locations.
7. The argument is not understood. Even if applicant's argument were relevant to *Larson's* invention the claim language does not reflect applicant's concerns.
8. As per claim 15 applicant suggests that in response to a wireless device print devices discovery request, the print devices response does not include a printer's capabilities information.
9. This argument has been carefully considered but was not found persuasive. The examiner points out that the mere fact of a response from a printer is conformation of printer's capabilities: e.g. receive a print job, print the print job etc.
10. As per claim 18 applicant argues that in *Larsson's* system it is assumed that the information service provider has a print service that will format information for printing. Applicant contrasts *Larsson's* system with applicant's invention where the information added to the reference includes a locator that identifies the location of a print service that can be used to format referenced content for printing.
11. This argument is not understood since the presumed deficiency of *Larsson's* invention does not change the fact that even if applicant's interpretation were correct *Larsson's* teaching still reads on the claim language limitations.
12. The examiner points to § 32-33 of the previous Office Action, wherein this limitation has been addressed.

13. As per claims 37-39 applicant once again points to the importance that the print content and print service are in different locations.
14. The argument is not understood. Even if applicant's argument were relevant to *Larsson's* invention the claim language does not reflect applicant's concerns.
15. As per claims 4 and 20 applicant traverses the examiner's rejection over *Larsson* in view of *Saylor*. Applicant states that although *Saylor* does teach a billing module the combination is inappropriate since the reference has nothing to do with printing operations.
16. The examiner points out that in col. 31 lines 1-7 *Saylor* teaches passing billing information. Although *Saylor* does not explicitly talk about printing, the examiner points out that *Saylor's* teaching is very relevant to *Larsson's* invention. Both inventions are concerned with retrieving a content. Even if both inventions did not utilize a mobile telephone (as they did) in obtaining the content, the idea of billing for use of content is old and well-known to not only to one of ordinary skill in the art and *Saylor's* reference has been provided as an example that passing billing information would simply be obviousness.
17. Applicant traverses the rejection of claim 21 (*Larsson in view of Official Notice*). Applicant does not share the opinion that a format data instructing a print device to print the beginning on a new sheet is well known in the art.
18. This argument has been considered but is not persuasive. The current Office Action explicitly addresses applicant's concern (below).

19. As per claims 9-12 and 32-34 applicant argues that *Larsson*, *Takahashi* and *Yoon* don't teach wireless initiation of a print by reference operation with a print device.
20. The examiner points out that the argument is not understood. The claim language (claims 9-12 and 32-34) simply calls for wirelessly communicating a security access code to the print device. The security access code is communicated in response to a security challenge received from the print device and enables usage of the print device. The examiner addresses once again the claimed limitation in the current Office Action.
21. Furthermore, as per the argument that the *Takahashi* reference is irrelevant since "the user of a PDA is likely to keep the PDA on the person" and "the wireless device 100 in Larsson does not have the same security concerns that the personal computer of *Takahashi* does", the examiner points out that the teaching was to address a computer interface communicating a security access code enabling usage of the print device. This is exactly what *Takahashi* aims to address [83] and provides motivation to combine with other inventions [2, 84-86].
22. As per claims 11 and 34 applicant argues that the *Yoon* reference does not indicate how to modify *Larsson*'s system so that a security access code is communicated to the print device enabling access to the print content.
23. This argument has been considered but was not found persuasive. The examiner points to the *Yoon*'s Abstract, which discloses sending a security access code enabling access. In the disclosure *Yoon* presents two communicating entities one of which requests an access and another that receives an authentication value and

provides services. Applicant's dilemma in understanding how one would accommodate Yoon's idea in Larsson's teaching, wherein both of the inventions deal with an interaction between a requester and a provider, is not clear.

24. Applicant's arguments in regard to claims 19 and 22 are found persuasive.

The new search has resulted in newly discovered prior art. New grounds of rejection based on the newly discovered prior art follow below.

25. Claims 4-5, 9-12, 15, 18-22, 32-34 and 37-39 have been examined.

26. Claims 37-39 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections.

See MPEP § 2172.01.

27. Claim 37 recites a portable wireless device in terms of interaction with a print service and a print device. Although, the claim language further expandson a print service, claim 37 never discusses the relationship of the portable wireless device and the print device.

28. Claims 38 and 39 are rejected by the virtue of their dependence.

Appropriate correction is required.

29. Claims 5, 15, 18 are rejected under 35 U.S.C. 102(b) as being anticipated by

Larsson et al. (International Publication No. WO 0142894).

30. *Larsson et al.* teach a print device communication device (300b) receiving a document address from the cellular telephone and transmitting the document address and the printer specification to the information service provider (pg. 13, lines 34-35), information service provider (200) which is a server for serving the documents and provides access to documents or other browsable information (pg. 13 lines 11-15), and a print service device (210) implemented in the information service provider and handling the request of a document to be printed (pg. 13 lines 15-22). Afterwards the retrieved document is sent to the target printer (pg. 17 lines 27-31).

31. As per claim 15 *Larsson et al.* teach wirelessly communicating a discovery signal to a print device and receipt of a responsive signal identifying the print device within the reach of the telephone (pg. 20 line 15- pg. 21 line 11).

32. As per claims 5 and 18 *Larsson et al.* teach communicating a reference to a print service, the reference identifying a location at which a print content is located on a network, wherein the reference causes the print service to retrieve the print content (pg. 21 lines 1-11). *Larsson et al.* teach providing the print service (print service device) with printer's specification (col. 16 lines 7-9) upon which the document is retrieved (pg. 16 lines 13-20) and converted using a portion of the printer specification containing data for selecting an appropriate device driver to determine what device driver to use for creating the print file (pg. 17 lines 11-15).

33. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Saylor et al.* (*U.S. Patent No.6501832*).

34. As per claims 4 and 20 *Larsson et al.* teach a print device communication device (300b) receiving a document address from the cellular telephone and transmitting the document address and the printer specification to the information service provider (pg. 13, lines 34-35), information service provider (200) which is a server for serving the documents and provides access to documents or other browsable information (pg. 13 lines 11-15), and a print service device (210) implemented in the information service provider and handling the request of a document to be printed (pg. 13 lines 15-22). Afterwards the retrieved document is sent to the target printer (pg. 17 lines 27-31).

Furthermore, *Larsson et al.* teach a communication device transmitting the document address and the printer specification to the information service provider. The printer specification comprises data regarding the transport route for a print file that is to be printed (pg. 13 line 35 - pg. 14 line 4).

35. *Larsson et al.* do not teach adding billing information to the reference. *Saylor et al.* teach adding billing information to the reference (*Saylor et al.*, col. 31 lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add billing information to the reference as taught by *Saylor et al.* One of ordinary skill in the art would have been motivated to perform such a modification in

order to properly charge users for accessing the per fee content (*Saylor et al.*, col. 39 lines 44-49 and col. 27 lines 42-46).

36. Claims 9-10, 12, 19 and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Takahashi* (*U.S. Pub. No 20010016912*).

37. *Larsson et al.* teach a print device communication device (300b) receiving a document address from the cellular telephone and transmitting the document address and the printer specification to the information service provider (pg. 13, lines 34-35), information service provider (200) which is a server for serving the documents and provides access to documents or other browsable information (pg. 13 lines 11-15), and a print service device (200) implemented in the information service provider and handling the request of a document to be printed (pg. 13 lines 15-22). Afterwards the retrieved document is sent to the target printer (pg. 17 lines 27-31).

38. *Larsson et al.* do not explicitly teach the computer interface communicating a security access code (in response to a security challenge received from the print device) to the print device enabling usage of the print device.

Takahashi teaches the computer interface communicating a security access code to the print device enabling usage of the print device [83]. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a security access code to the print device enabling usage of the print device as taught by *Takahashi*. One of ordinary skill in the art would have been motivated to perform

such a modification in order to improve the print security function (*Takahashi, [05]*) and avoid waste printing (*Takahashi, [2] and [84]-[86]*).

Takahashi teaches that the printing is not executed as long as a person with print authority is identified (*Takahashi [83]*) and as a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement a challenge from the print device if the request were provided without a security access code. One of ordinary skill in the art would have been motivated to perform such a modification in order to print content by providing an appropriate security access code.

39. Claims 11 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Takahashi* (*U.S. Pub. No 20010016912*) and in further view of *Yoon et al.* (*U.S. Patent No. 6173407*).

40. *Larsson et al.* in view of *Takahashi* teach the computer program product being sent to the printer causing the print device to access print content which is the Internet content as discussed above.

Larsson et al. in view of *Takahashi* do not explicitly teach the computer interface communicating a security access code to the print device enabling access to the print content.

Yoon et al. teach sending a security access code enabling access to the print content (*Internet content, Yoon et al., Abstract*).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to send access code enabling access to the print content as taught by *Yoon et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to allow access to fee-based content and determine the charges for the content usage (*Yoon et al.*, col. 1 lines 45-60).

41. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Minasi* (*Mark Minasi, "Mastering Windows NT Server 4, 6th edition, 1999, ISBN: 0782124453*).
42. *Larsson et al.* teach a print device communication device (300b) receiving a document address from the cellular telephone and transmitting the document address and the printer specification to the information service provider (pg. 13, lines 34-35), information service provider (200) which is a server for serving the documents and provides access to documents or other browsable information (pg. 13 lines 11-15), and a print service device (200) implemented in the information service provider and handling the request of a document to be printed (pg. 13 lines 15-22). Afterwards the retrieved document is sent to the target printer (pg. 17 lines 27-31).
43. *Larsson et al.* do not teach adding information comprising print format data instructing the print device to print the print content beginning on a new sheet. *Minasi* teach information comprising print format data instructing the print device to print separator pages, which are extra pages that are printed before the main print

content (pg. 583, "Separator Pages for Sorting Documents), which results in the print content beginning on a new sheet.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add information comprising print format data instructing the print device to print separator pages that would result in the print content to begin on a new sheet as taught by *Minasi*. One of ordinary skill in the art would have been motivated to perform such a modification in order to identify the owner of the print job, record the print time and data etc (pg. 583, "Separator Pages for Sorting Documents).

44. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Ochiai* (U.S. Patent No. 6583886).

45. *Larsson et al.* do not teach a request and respond for/to status information.

Ochiai teaches a request (and respond) for status information (col. 8 lines 6-16). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to communicate a request (and respond) for status information as taught by *Ochiai*. One of ordinary skill in the art would have been motivated to perform such a modification in order to be able to monitor the print job.

46. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*) in view of *Bhogal et al.* (U.S. Pub. 20030020944).

47. *Larsson et al.* teach a print device communication device (300b) receiving a document address from the cellular telephone and transmitting the document

address and the printer specification to the information service provider (pg. 13, *lines 34-35*), information service provider (200) which is a server for serving the documents and provides access to documents or other browsable information (pg. 13 *lines 11-15*), and a print service device (200) implemented in the information service provider and handling the request of a document to be printed (pg. 13 *lines 15-22*). Afterwards the retrieved document is sent to the target printer (pg. 17 *lines 27-31*).

48. *Larsson et al.* do not teach adding information comprising print format data instructing the print device to print the print content beginning on a new sheet. *Bhogal et al.* teach information comprising print format data instructing the print device to print the print content beginning on a new sheet [*Bhogal et al.*, 5]. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add information comprising print format data instructing the print device to print the print content beginning on a new sheet as taught by *Bhogal et al.* One of ordinary skill in the art would have been motivated to perform such a modification in order to provide additional format to allow additional reformat information *Bhogal et al.* [5].

49. *Larsson et al.* do not teach a request and respond for/to status information. *Bhogal et al.* teach a request and respond for/to status information [*Bhogal et al.*, 8]. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to add a request and respond for/to status information as taught by *Bhogal et al.*

et al. One of ordinary skill in the art would have been motivated to perform such a modification in order to be notified of a print job status [*Bhogal et al.*, 8].

50. Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Larsson et al.* (*International Publication No. WO 0142894*).

51. As per claim 37 *Larsson et al.* teach a communication device (300) comprising a first communication interface adapted to enable wireless communication between the communication device and a print service (60) and a second communication interface adapted to enable wireless communication between the wireless device and a print device (380). The communication device communicates a reference that identifies the location of a print service content to the print service, wherein communicating the reference to the print service causes the print service to retrieve the print content from a network and further causes the print service to transmit the print content to the wireless device (*Fig. 4, pg. 15 lines 29-32, pg. 13 lines 33- pg. 4 lines 4*).

52. *Larsson et al.* do not explicitly teach that the communication device is a portable communication device. However, is old and well-known practice to move about network computing devices and as a result it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to implement a wireless device in *Larsson et al.*'s invention as a portable wireless device. One of ordinary skill in the art would have been motivated to perform such a modification in order to be able to change the location of the wireless device.

53. As per claim 38 *Larsson et al.* teach providing the print service (print service device) with printer's specification (col. 16 lines 7-9) upon which the document is retrieved (pg. 16 lines 13-20) and converted using a portion of the printer specification containing data for selecting an appropriate device driver to determine what device driver to use for creating the print file (pg. 17 lines 11-15).

54. The limitations of claim 39 are implicit as Fig. 4 shows that the wireless device is connected to the printer 380.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Poltorak whose telephone number is (571)272-3840. The examiner can normally be reached Monday through Thursday from 9:00 a.m. to 4:00 p.m. and alternate Fridays from 9:00 a.m. to 3:30 p.m

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse can be reached on (571)272-3838. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Signature


Date


GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100